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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,415	11/21/2000	Masaru Takeda	107904	8263
25944	7590	06/30/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			NGUYEN, HAI V	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,415

Applicant(s)

TAKEDA ET AL.

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-22 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 May 2005 has been entered.

2. Claim 22 is new.

3. Claims 1-22 are presented for examination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cantwell** U.S. patent # **6,542,892 B1** in view of **Thorne** U.S. patent # **5,832,191** and further in view of **Okada** et al. U.S patent #: **6,307,643 B1**.

6. As to claim 1, Cantwell, Configuring A Client For A printer Using Electronic Mail, discloses an information output system comprising:

a managing section managing for managing a mail address for each output printing apparatus (*Fig. 1, Administrator manages Pass List Server 16 having e-mail*

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address of printer 12, col. 1, lines 35-60). However, Cantwell does not explicitly disclose searching an output printing apparatus group managed by the managing section for one candidate output printing apparatus or a plurality of candidate output printing apparatuses in response to a search request from a terminal apparatus. Thus, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus for implementing searching an output printing apparatus group managed by the managing section for one candidate output printing apparatus or a plurality of candidate output printing apparatuses in response to a search request from a terminal apparatus.

In the same field of endeavor, Thorne, related Method And Apparatus For Automatically Enabling Communication With A Network Printer, discloses that *when server 34 receives printer request from client, service registry is searched for list of available public access printers, Fig. 4, box 118*).

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Thorne's teachings of searching available printers (*Fig. 4, box 118*) with the teachings of Cantwell, for the *purpose of enabling automatic configuration of all data required to enable access to a newly connected network printer (Thorne, col. 1, line 66 – col. 2, line 2)*.

Cantwell discloses notifying said terminal apparatus of the mail address of said candidate output printing apparatus or the plurality of candidate output printing apparatus found in a search by the search section, wherein the terminal apparatus issues an electronic mail to a destination mail address of a designate output printing

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apparatus, and wherein the destination mail address is based upon the mail address of said candidate output printing apparatus or the plurality of candidate output printing apparatus provided by the notifying section (*Cantwell, the user is prompted for an email address of printer 12, col. 2, lines 62-67*); and

Cantwell discloses distinguishing the designated output printing apparatus from said output printing apparatus from said output printing apparatus group based on the destination mail address of the electronic mail issued from said terminal apparatus (*Cantwell, the user is prompted for an email address of printer 12, col. 2, line 62 – col. 3, line 3*); However, Cantwell-Thorne does not explicitly disclose said designated output printing apparatus produces printed output of outputting information included in the electronic mail issued from said terminal apparatus. Thus, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus for implementing said designated output printing apparatus produces printed output of outputting information included in the electronic mail issued from said terminal apparatus.

In the same field of endeavor, Okada, related Facsimile Machine, discloses in claim 9 that *a receiving section configured to receive an e-mail and to instruct said printer to print a content included in the received e-mail (col. 20, lines 1-3)*.

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Cantwell-Thorne's teachings of managing and searching available printers with the teachings of Okada, for the *purpose*

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of enabling carrying out the print job (*Okada, col. 20, lines 1-3; Thorne, col. 4, lines 45-52*).

7. As to claim 2, Cantwell-Thorne-Okada discloses managing performance information for each of said output printing apparatuses, and said search section searches for said one candidate output printing apparatus or the plurality of candidate output printing apparatuses based on said performance information (*Thorne, various status indications concerning printer, col. 4, lines 23-33*).

8. As to claim 3, Cantwell-Thorne-Okada discloses, wherein said managing section further manages installation position information for each of said output printing apparatuses, and said search section searches for said one candidate output printing apparatus or the plurality of candidate output printing apparatuses based on said installation position information (*Thorne, Fig. 1, address of printer in CDS 58*).

9. As to claim 4, Cantwell-Thorne-Okada discloses an accounting processor for performing accounting processing before outputting the information included in said electronic mail. (*Cantwell, Fig. pass list server 4 also includes software for tracking print job, lad balancing, billing, resource ordering, and other desirable function, col. 2, lines 35-40*)

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 5-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cantwell-Thorne-Okada** as applied to claims 1-4 above, and further in view of **Tanaka et al.** U.S patent #: **6,519,048 B1**.

12. As to claim 5, Cantwell-Thorne-Okada does not explicitly disclose the limitation of "converting information included in the electronic mail in accordance with the designated printer". Thus, the artisan would have been motivated to look into the related networking arts for potential methods and apparatus for implementing the converting information included in the electronic mail in accordance with the designated printer.

In the same field of endeavor, Tanaka, Image Forming Apparatus, Image Forming Method, And Storage Medium Storing Computer Readable Program Therein discloses, *"an image data manager for converting an image format of raster image data for print output into a format adapted to an application of the client so that it can be visually grasped by the client who requested the print job and for storing the converted format. As an image format, a JPEG image format or a PDF image format is suitable, Fig. 1, box 106, col. 7, lines 18-27)*

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Tanaka's teachings of converting the print data into a format received by the printer with the teachings of Cantwell-Thorne-Okada for the *purpose of providing a desired printout results (Tanaka, col. 2, lines 25-30).*

Tanaka discloses said designated printer prints output of the said converted information *(Tanaka, In step S504, when the print data is normally printed the raster image*

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converting means (6) converts the color attributes of YMCK into the color attributes of RGB on the basis of the raster image data used in the printing, converts the format of the RGB color image into the JPEG image format, and generates the image data to display the print result. The image data is opened to a specific client by the image data opening means (8), col. 10, lines 17-28).

13. As to claim 6, Cantwell-Thorne-Okada-Tanaka discloses, wherein said first server further comprises: an information managing section for managing performance information and installation position information for each of said printers (*Thorne, various status indications concerning printer, col. 4, lines 23-33; Fig. 1, address of printer in CDS 58*); and an information notifying section for notifying said client of at least one of the candidate printer or the plurality of candidate printers (*Cantwell, the user is prompted for an email address of printer 12, col. 2, lines 62-67*).

14. As to claim 7, Cantwell-Thorne-Okada-Tanaka discloses, wherein the electronic mail is utilized to perform communication between said client and said first server (*Cantwell, Fig. 1, print server 10*).

15. As to claim 8, Cantwell-Thorne-Okada-Tanaka discloses, further comprising an authentication apparatus for performing user authentication prior to print processing of said converted information in said designated printer (*Cantwell, The sender is checked 34 against a pass list 20 either on the print server 10 or against a list 20 on the pass-list server 16. If the sender is not an allowed user, the e-mail is discarded. Optionally, print server 10 sends 36 a negation reply e-mail to the user, col. 3, lines 4-13*).

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16. As to claim 9, Cantwell-Thorne-Okada-Tanaka discloses separating said electronic mail into a plurality of mail elements; and an individual managing section for individually managing said respective separated mail elements, and said information to be printed corresponds to one mail element (*Okada, col. 12, lines 62-67*).

17. As to claim 10, Cantwell-Thorne-Okada-Tanaka discloses a storing section in which the information constituting said electronic mail is stored; a monitor section for monitoring an empty capacity of said storing section; and a restricting section for restricting reception of a print request in accordance with lack of capacity of said storing section (*Okada, Figs. 19-20; col. 19, lines 28-62; col. 14, lines 11-61*).

18. As to claim 11, Cantwell-Thorne-Okada-Tanaka discloses notifying said client of reception restriction when the reception of said print request is restricted (*Okada, Figs. 19-20; col. 19, lines 28-62; col. 14, lines 11-61*).

19. As to claim 12, Cantwell-Thorne-Okada-Tanaka discloses converting the information included in said electronic mail to a PDL file in accordance with said designated printer (*Tanaka, col. 7, lines 18-27*).

20. Claim 13 is similar limitation of claim 12; therefore, it is rejected under the same rationale as in claim 12.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cantwell-Thorne-Okada-Tanaka as applied to claims 1-13 above, and further in view of the well-known feature of checking virus in the electronic mail.

23. As to claim 14, Cantwell-Thorne-Okada-Tanaka does not explicitly disclose executing a virus check with respect to said electronic mail.

The Examiner **takes Official Notice (see MPEP 2144.03)** that it is well known in the networking art to utilize virus-checking software for checking and execution of the method and system in order to provide the outputting. Therefore, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have included the virus checking program used in electronic mail because the virus checking programs is just the matter of design choices (*see Chen et al., patent # 5,832,208; col. 5, line 2 – col. 2, line 4*).

24. Claims 15-16 are similar limitations of claim 14, 4; therefore, it is rejected under the same rationale as in claim 14, 4.

25. Claim 17 is similar limitations of claims 1,4; therefore, it is rejected under the same rationale as in claims 1, 4.

26. Claim 18 is similar limitations of claim 4; therefore, it is rejected under the same rationale as in claim 4.

27. Claim 19 is corresponding method claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

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28. Claim 20 is corresponding computer readable medium of claim 1; therefore, it is rejected under the same rationale as in claim 1.

29. Claim 21 is similar limitations of claim 5; it is rejected under the same rationale as in claim 5.

30. As to claim 22, Cantwell-Thorne-Okada-Tanaka discloses, wherein the terminal is capable of sending and receiving electronic mail (*Okada, Fig. 2, PC 211*).

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31. Further references of interest are cited on Form PTO-892, which is an attachment to this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai V. Nguyen
Examiner
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ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER